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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/333,894	06/14/1999	ARSHISH Cyrus KAPADIA	0544MH-3426	4656

7590 03/19/2003

ATTEN: CHRISTOPHER W. KENNERLY, ESQ.  
BAKER BOTTS L.L.P.  
2001 ROSS AVENUE  
SUITE 600  
DALLAS, TX 75201-2980

EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

**Office Action Summary**

Application No.

09/333,894

Applicant(s)

KAPADIA ET AL.

Examiner

Mark A Fadok

Art Unit

3625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 2/5/2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 6-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

The examiner is in receipt of Applicant's response to Office Action mailed 11/14/2002, which was received by the Office 2/5/2003. Acknowledgement is made to the amendments of claims 1-4, 6-29, 31, 36, 37, and 39 and that no claims were added or canceled, leaving claims 1-4 and 6-43 as pending. The arguments were carefully considered, but were found not to be persuasive. The following is a new rejection that was necessitated by the amendment.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-4 and 6-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (6,167,383), in view of Applicant's Disclosure, in view of Nick (6,009,406) and further in view of Official Notice.**

In regards to claims 1-4 and 6-43, Henson discloses all of the features except as follows: Henson teaches providing options and configuring a product based on various options which may cause a ripple effect to the over all configuration (FIG 5, "1 - selection may require changes to other configurations choices". The Examiner believes that the optimization function is inherent in the calculations made to reconfigure the product and the price changes associated with this reconfiguration would be considered

an optimization, since if the changes were not made then the manufacturer would have to absorb the cost. Also FIG 5 shows what is "featured" as being the default configuration. However, in the interest of compact prosecution, the Applicant may chooses to argue that Henson does not specifically mention an optimization function for this purpose or an Available To Promise (ATP) application, the Examiner offers the following in anticipation of these arguments:

As stated in Applicant's disclosure, use and design of optimization functions and ATP's in determining an optimal configuration is old and well known in the art. (Specification, page 21,9 and 8). Furthermore, Nick teaches product optimization through the maximization of standard modules, components and parts (see at least summary and FIG 1). It would be obvious to a person having ordinary skill in the art to include in Henson the optimization functions as taught by the Applicant's Disclosure or Nick, because a manufacturing company is always modifying there sales strategy, therefore, to better implement the strategy would require an optimization function that dynamically matches the desired outcome of the strategy.

Henson teaches notifying the user that a selected item will require additional lead-time, but does not specifically mention that the user specify before hand the delivery date required. It is old and well known in the art for a customer to provide a required date in relation to placing an order. It would be obvious to a person of ordinary skill in the art to include in Henson allowing a user to specify a date required, because this would allow Henson to eliminate some of the options to the user that have lead-

times that exceed the users required delivery date and preclude consideration of those items from the list.

Henson teaches notifying the customer that a product is not currently available and will require an extended lead-time, but does not specifically mention that the configuration is not presented to the user when the part is not available. It is old and well known in the art that information presentment can be modified/limited based on the desired output, therefore, it would have been obvious to a person of ordinary skill in the art to include in Henson not presenting a configuration that is not immediately available to a customer that presented criteria that eliminates the configuration as an order option, because this would eliminate choices to the customer of configuration that do not meet a specified delivery date and might reduce confusion.

### ***Response to Arguments***

The Applicant's arguments received 2/5/2003 have been carefully considered, but were found not to be persuasive:

In regards to Applicant's argument that Henson discloses nothing whatsoever regarding an optimization function, much less the optimization functions and associated operations recited in Applicant's independent claims.

Henson teaches providing options and configuring a product based on various options which may cause a ripple effect to the over all configuration (FIG 5, "1 - selection may require changes to other configurations choices". The Examiner believes that the optimization function is inherent in the calculations made to reconfigure the

product and the price changes associated with this reconfiguration would be considered an optimization, since if the changes were not made then the manufacturer would have to absorb the cost. Also FIG 5 shows what is "featured" as being the default configuration. However, in the interest of compact prosecution, the Applicant may chooses to argue that Henson does not specifically mention an optimization function for this purpose or an Available To Promise (ATP) application, the Examiner offers the following in anticipation of these anticipated argument:

As stated in Applicant's disclosure, use and design of optimization functions and ATP's in determining an optimal configuration is old and well known in the art. (Specification, page 21,9 and 8). Furthermore, Nick teaches product optimization through the maximization of standard modules, components and parts (see at least summary and FIG 1). It would be obvious to a person having ordinary skill in the art to include in Henson the optimization functions as taught by the Applicant's Disclosure or Nick, because a manufacturing company is always modifying there sales strategy, therefore, to better implement the strategy would require an optimization function that dynamically matches the desired outcome of the strategy.

In regards to Applicant's argument that Henson provides the user with a warning indicator to indicate an option which, if already selected or selected in the future by the user, would represent an invalid configuration or would adversely impact the shipment or delivery date of the configured product. I.e. the user is presented with all options and remains free to at least initially select any of these options. Henson teaches notifying the customer that a product is not currently available and will require an extended lead-

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time, but does not specifically mention that the configuration is not presented to the user when the part is not available. It is old and well known in the art that information presentment can be modified/limited based on the desired output, therefore, it would have been obvious to a person of ordinary skill in the art to include in Henson not presenting a configuration that is not immediately available to a customer that presented criteria that eliminates the configuration as an order option, because this would eliminate choices to the customer of configuration that do not meet a specified delivery date and might reduce confusion.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Friday 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

**(703) 305-7687** [Official communications; including  
After Final communications labeled  
"Box AF"]

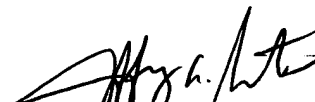
**(703) 746-7206** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



Mark Fadok

Patent Examiner



Jeffrey A. Smith  
Primary Examiner